

Atty. Dkt. No. 025782-0112 f/k/a 35451/108 (Palm 3569.Palm)

### REMARKS

Applicant respectfully requests entry of the foregoing amendments under 37 C.F.R. 1.116. Applicants believe that entry of the foregoing amendments would place this application in condition for allowance. Thus, entry of the foregoing amendments and favorable reconsideration of the application as amended is respectfully requested.

Claims 1-51 are currently pending in the application, with claims 1-29 remaining withdrawn from consideration.

Claims 31, 32, 36, 42, 43, and 47 are requested to be amended.

Claims 30, 40, 41, and 51 are requested to be canceled without prejudice.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each.

If the foregoing amendments are entered, claims 1-29, 31-39 and 42-50 will remain pending in this application.

### Claim Objections

In the Office Action, claims 30 and 41 are objected to because of an apparent typo. Claims 30 and 41 have been canceled. Accordingly, Applicants respectfully submit that the objection to claims 30 and 41 is rendered moot.

### Claim Rejections – 35 U.S.C. § 102(e)

In the Office Action, claims 30-32, 37-39, 41-43, and 48-50 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lai (U.S. Patent No. 6,593,860). As explained below, Lai fails to disclose the claimed invention, particularly as amended.

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**a. Claims 30-32 and 37-39**

Claim 30 is hereby canceled without prejudice, thus rendering the rejection of claim 30 under 35 U.S.C. § 102(e) moot. Claims 31, 32, and 37-39, which formerly depended from claim 30 have been amended as necessary to depend from claim 36. As explained below, claim 36 has been rewritten in independent form to include all of the limitations of claim 30, and Applicants believe that claim 36 (as rewritten) constitutes a patentable base claim. Thus, claims 31, 32, and 37-39 are believed patentable over Lai for at least the reason that they add further limitations to a patentable base claim. Accordingly, Applicants request that the rejection of claims 31, 32, and 37-39 under 35 U.S.C. § 102(e) be withdrawn.

**b. Claims 41-43 and 48-50**

Claim 41 is hereby canceled without prejudice, thus rendering the rejection of claim 41 under 35 U.S.C. § 102(e) moot. Claims 42, 43, and 48-50, which formerly depended from claim 41 have been amended as necessary to depend from claim 47. As explained below, claim 47 has been rewritten in independent form to include all of the limitations of claim 47, and Applicants believe that claim 47 (as rewritten) constitutes a patentable base claim. Thus, claims 42, 43, and 48-50 are believed patentable over Lai for at least the reason that they add further limitations to a patentable base claim. Accordingly, Applicants request that the rejection of claims 42, 43, and 48-50 under 35 U.S.C. § 102(e) be withdrawn.

**Claim Rejections – 35 U.S.C. § 103(a)**

In the Office Action, claims 33-36, 40, 44-47, and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lai in view of Kanevsky (U.S. Patent No. 6,300,947). Each specific rejection is addressed below.

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**a. Claims 33-36 and 40**

With this response, claim 36 has been rewritten in independent form including all of the limitations of claim 30, from which claim 36 previously depended, and claim 40 has been canceled without prejudice. Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 36 (as rewritten) because there is no suggestion or motivation to modify Lai or to otherwise combine the teachings of Lai and Kanevsky. The Office Action states with regard to claim 36 that "Kanevsky discloses the first server is configured to retrieve the converted format and is configured to send the converted format to the handheld device (col. 16, lines 34-36)." The Office Action, however, does not provide any indication as to why one of ordinary skill in the art would be motivated to combine the cited teaching of Kanevsky with the teachings of Lai to somehow arrive at the subject matter of claim 36. In the absence of a recitation of a motivation to combine the cited combination of references, the rejection of claim 36 under 35 U.S.C. § 103(a) is improper. See Manual of Patent Examining Procedure § 2143.01.

The rejection of claim 36 under 35 U.S.C. § 103(a) based on the cited combination of Lai in view of Kanevsky is also improper because the proposed combination of the teachings of Lai and Kanevsky would change the principle of operation of Lai. As such, there would be no suggestion or motivation to combine the cited combination of references. Lai teaches that:

Because transcoded media content is streamed to the viewer client 102 by a streaming server and/or proxy server as will be discussed in more detail herein, the viewer Web server interface 202 sends a reply to the viewer client 102 redirecting the viewer client 102 to the appropriate server from which to receive the requested media content.

Col. 9, lines 19-25. Lai also teaches that:

In embodiments, each streaming server within the machine farm 216 is a type-specific streaming server dedicated to the delivery of media content of a single type. For example, a streaming server within the machine farm 216 may be dedicated to delivering transcoded media content in REAL format, WINDOWS MEDIA

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format, QUICK TIME format, etc. The streaming servers 222 within the machine farm may run off-the-shelf industry-standard streaming server programs, streaming server programs that are implemented according to a public standard, or proprietary streaming server programs.

Col. 10, line 65 – col. 11, line 9. Lai further discloses several examples of media content and publishing variables for which the transcoding system is applicable, including, for example, content types such as “HTML pages” and “XML documents, and video publication variables such as “the width and height of the video image.” See col. 18, line 63 – col 23, line 18. Thus, viewed as a whole, Lai teaches the use of Web server interface 202 to redirect the viewer client 102 to one of several dedicated streaming servers to receive the various types of transcoded media content, including, for example, transcoded web pages.

Kanevsky teaches that “[t]he transformed set of pages from server 107 are sent to the server 104,” via connection 111a, and then onto the client machine 100 from the server 104, via connection 111.” Col. 7, lines 42-44. Thus, viewed as a whole, Kanevsky teaches the use of a single server 104 (suggested by the Office Action as being analogous to the Web server interface 202 of Lai) to receive all transformed web pages and to send the transformed web pages to the client machine 100. To modify the teachings of Lai, as the Office Action suggests, such that some or all transcoded media content is routed to viewer client 102 through Web server interface 202 would require a substantial and unnecessary redesign of the elements shown in Lai, and would change the principle of operation under which the architecture of Lai was designed to operate (i.e., the use of Web server interface 202 to redirect the viewer client 102 to one of several dedicated streaming servers to receive the various types of transcoded media content, including, for example, transcoded web pages). Accordingly, the combined teachings of Lai and Kanevsky are not sufficient to render the subject matter of claim 36 *prima facie* obvious because there is no suggestion or motivation to combine the teachings of these references. See Manual of Patent Examining Procedure § 2143.01. Any suggestion or motivation to combine the teachings of Lai and Kanevsky has been taken from Applicants’ own disclosure using hindsight, which is improper.

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Accordingly, Applicants request that the rejection of claim 36 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 33-35 depend from claim 36 and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

**b. Claims 44-47 and 51**

With this response, claim 47 has been rewritten in independent form including all of the limitations of claim 41, from which claim 47 previously depended, and claim 51 has been canceled without prejudice. Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with regard to claim 41 (as amended) because there is no suggestion or motivation to modify Lai or to otherwise combine the teachings of Lai and Kanevsky. The Office Action states with regard to claim 47 that "Kanevsky discloses the first server is configured to retrieve the converted format and is configured to send the converted format to the handheld device (col. 16, lines 34-36)." The Office Action, however, does not provide any indication as to why one of ordinary skill in the art would be motivated to combine the cited teaching of Kanevsky with the teachings of Lai to somehow arrive at the subject matter of claim 47. In the absence of a recitation of a motivation to combine the cited combination of references, the rejection of claim 47 under 35 U.S.C. § 103(a) is improper. See Manual of Patent Examining Procedure § 2143.01.

The rejection of claim 36 under 35 U.S.C. § 103(a) based on the cited combination of Lai in view of Kanevsky is also improper because the proposed combination of the teachings of Lai and Kanevsky would change the principle of operation of Lai. As such, there would be no suggestion or motivation to combine the cited combination of references. Lai teaches that:

Because transcoded media content is streamed to the viewer client 102 by a streaming server and/or proxy server as will be discussed in more detail herein, the viewer Web server interface 202 sends a reply to the viewer client 102 redirecting the viewer client 102 to the appropriate server from which to receive the requested media content.

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Col. 9, lines 19-25. Lai also teaches that:

In embodiments, each streaming server within the machine farm 216 is a type-specific streaming server dedicated to the delivery of media content of a single type. For example, a streaming server within the machine farm 216 may be dedicated to delivering transcoded media content in REAL format, WINDOWS MEDIA format, QUICK TIME format, etc. The streaming servers 222 within the machine farm may run off-the-shelf industry-standard streaming server programs, streaming server programs that are implemented according to a public standard, or proprietary streaming server programs.

Col. 10, line 65 – col. 11, line 9. Lai further discloses several examples of media content and publishing variables for which the transcoding system is applicable, including, for example, content types such as “HTML pages” and “XML documents, and video publication variables such as “the width and height of the video image.” See col. 18, line 63 – col 23, line 18. Thus, viewed as a whole, Lai teaches the use of Web server interface 202 to redirect the viewer client 102 to one of several dedicated streaming servers to receive the various types of transcoded media content, including, for example, transcoded web pages.

Kanevsky teaches that “[t]he transformed set of pages from server 107 are sent to the server 104,” via connection 111a, and then onto the client machine 100 from the server 104, via connection 111.” Col. 7, lines 42-44. Thus, viewed as a whole, Kanevsky teaches the use of a single server 104 (suggested by the Office Action as being analogous to the Web server interface 202 of Lai) to receive all transformed web pages and to send the transformed web pages to the client machine 100. To modify the teachings of Lai, as the Office Action suggests, such that some or all transcoded media content is routed to viewer client 102 through Web server interface 202 would require a substantial and unnecessary redesign of the elements shown in Lai, and would change the principle of operation under which the architecture of Lai was designed to operate (i.e., the use of Web server interface 202 to redirect the viewer client 102 to one of several dedicated streaming servers to receive the transcoded media content, including, for example, transcoded web pages). Accordingly, the combined teachings of Lai and Kanevsky are not sufficient to render the subject matter of claim 47 *prima facie* obvious because there is no

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suggestion or motivation to combine the teachings of these references. See Manual of Patent Examining Procedure § 2143.01. Any suggestion or motivation to combine the teachings of Lai and Kanevsky has been taken from Applicants' own disclosure using hindsight, which is improper.

Accordingly, Applicants request that the rejection of claim 47 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 44-46 depend from claim 47 and are thus patentable over the cited combination of references for at least the same reasons, and Applicants further request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well.

#### Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

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Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

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